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In re Application of :
Inada and Kubo :
Application No.: 10/781,263 : ON PETITION
Filing Date: February 19, 2004 :
Attorney Docket No. 087147-0494 :

This is a decision on the petition under 37 CFR 1.183 filed October 24, 2008, seeking waiver of 37 CFR §§ 1.67 and 1.175 where it requires that a supplemental declaration be executed by the named inventors in a broadening reissue application.¹

The petition is granted.

BACKGROUND

On February 19, 2004, the present application was filed as an application for reissue of U.S. Patent No. 6,348,481, by inventors Inada and Kubo, who executed an original reissue declaration.

During the prosecution of the present application, the Office required a supplemental declaration directed to errors in the original patent which were corrected in the present application after the signing of the original reissue declaration.

According to the statement supplied by applicant's legal representative, Stephen Maebius, and a statement provided by a representative of the assignee, together with the present petition, it is established that inventor Inada could not be located to sign the supplemental declaration after diligent effort to find him.

¹ Once an application has received a fully executed oath or declaration that has been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1), requires that:

“For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant.”

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all the inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of all the inventors. *See In re Hayes*, 53 USPQ2d 1222 (Comm’r Pat. 1999).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by an inventor.

The instant petition is accompanied by an appropriate showing that inventor Inada could not be located after diligent effort. Accordingly, the supplemental declaration of September 10, 2008, signed by inventor Kubo will be accepted as though it was signed by both joint inventors as required by 37 CFR 1.175(b)(1) taken in conjunction with 37 CFR 1.172. *See* MPEP 602.02. *See In re Hayes*, *supra*.

CONCLUSION

The present petition to waive 37 CFR 1.172 is granted.

The application is being forwarded to Technology Center Art Unit 1626 for further prosecution.

Please direct any questions related to this decision to the undersigned at (571) 272-3222.



Kenya A. McLaughlin
Petitions Attorney
Office of Petitions